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In re Application of
Qi Huang et al
Serial No.: 10/615,809
Filed: July 8, 2003
Attorney Docket No.: A-817

PETITION DECISION

This is in response to the petition under 37 CFR 1.181, filed January 19, 2007, requesting withdrawal of the Finality of the Office action mailed November 14, 2006.

BACKGROUND

A review of the file history shows that the examiner mailed a first Office action to applicants on December 7, 2005, setting forth a two way restriction requirement and an election of species requirement.

Applicants replied on February 27, 2006, by electing Group I and a species without traverse.

The examiner mailed a new Office action to applicants on April 13, 2006, acknowledging the election without traverse and the species elected. The examiner then, based on the species elected, arbitrarily determined the scope of the claims to be examined by defining variables R and R³. The examiner then rejected claim 1 under 35 U.S.C. 102(b) as anticipated by Lockermann et al. Claims 1-4, 8, 10-12, 16-17, 19, 23-25, 29 and 36 were rejected under 35 U.S.C. 102(b) over Huth et al (WO 00/27819). Claims 1-12, 16-17, 19, 23-25, 29-30, 32, 34 and 36 were rejected under 35 U.S.C. 103(a) as unpatentable over Altmann et al and the same claims were rejected for obvious double patenting over Altmann et al.

Applicants replied on August 22, 2006, amending claims 1-2, 5, 9, 17, 19-20 and 30 and canceling claims 4, 8, 12-16, 18 25-27 and 33. Applicants replied to all of the grounds of rejection asserted, and further objected to the examiner's determination of the scope of the claims to be examined as being improper.

The examiner mailed a Final Office action to applicants on November 14, 2006. The examiner withdrew all of the previous rejections of record in view of applicants' amendments. The examiner objected to claims 3 and 9 as failing to further limit the claim from which they depended. Claims 1-3, 5-7, 9-11, 17, 19-20, 22, 24, 29-32, 34 and 36 were objected to as containing non-elected subject matter. Claims 1-3, 10-11, 17, 19-20, 23-24, 29 and 36 were then rejected under 35 U.S.C. 102(b) as anticipated by Huth et al (WO 00/27819). Claims 5-7 and 9

were rejected under 35 U.S.C. 102(b) as anticipated, or under 35 U.S.C. 103(a) as unpatentable, over Huth et al (WO 00/27819), Patani et al or Fotouhi et al. Claims 30 and 34 were also rejected under 35 U.S.C. 103(a) as unpatentable over Huth et al in view of Patani et al and claim 31 was rejected under 35 U.S.C. 103(a) as unpatentable over Huth et al in view of Patani et al and Fotouhi et al.

Applicants filed this petition on January 19, 2007, objecting to the finality of the Office action as premature. Applicants also filed a reply to the Final Office action concurrently and have since filed a Notice of Appeal on February 14, 2007.

DISCUSSION

Applicants request withdrawal of the finality of the Office action of November 14, 2006, on the basis that the examiner's determination of the scope of the claims is improper and raises questions as to what is being examined inasmuch as the limitation imposed on one variable does not appear in the specification.

Applicants note that in the restriction requirement the examiner required an election of species and stated that upon electing a species the Office (i.e. – the examiner) would review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound. The Office action further stated that the restriction requirement would not be made Final until applicant was informed of the full scope of the invention under examination.

Applicants did not comment on these statements in response to the restriction requirement, but did object to the examiner's determination of the scope of the invention to be examined after receiving the next Office action which limited the scope of the claims. In addition, applicants clearly stated that the limitation of the claims introduced by the examiner was not supported by the specification and, in fact, encompassed embodiments excluded by the specification.

A review of the claims and the examiner's actions show the above to be partially correct. The examiner's statement which appears to set a limit on the scope of the claims to be examined was meant to inform applicants of the scope of the search pertaining to the claims, not limit the claim scope.

Further, the argument that the examiner's limitation that R^3 is a 6-membered ring consisting only of carbon and nitrogen may be inconsistent with the specification which defines R^3 as a 5 or 6-membered heterocyclyl ring meaning it cannot be an all carbon ring misconstrues the examiner's statement. It appears that the examiner intended the phrase to mean "six-membered nitrogen heterocycle ring", which is consistent with the elected species and prior art applied.

In view of the above the examiner's action in making the last Office action Final was not improper.

DECISION

The petition is **DENIED**.

The application will be forwarded to the examiner for consideration of applicants' reply to the Final Office action mailed November 14, 2007.

The time for filing an Appeal Brief or taking other appropriate action in response to the Notice of Appeal filed February 14, 2007, continues to run from that date and may be extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



George C. Elliott
Director, Technology Center 1600